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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,193	07/11/2001	Jukka Hautanen	4208-4014	9960

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EXAMINER	
LIANG, REGINA	

ART UNIT	PAPER NUMBER
2674	

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/903,193	HAUTANEN ET AL.	
	Examiner	Art Unit	
	Regina Liang	2674	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 March 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-68* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *41-49 and 52* is/are allowed.

6)☒ Claim(s) *1-5,7-25,27-40,50,51 and 53-68* is/are rejected.

7)☒ Claim(s) *6 and 26* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3-5, 7, 9, 10, 20, 23-25, 27, 29, 30, 50, 51, 53 are rejected under 35 U.S.C. 102(e) as being anticipated by Thompson et al (US. PAT. NO. 6,484,011 hereinafter Thompson).

As to claim 1, Thompson discloses a method of advertising to a user of a terminal (annunciator 10), comprising displaying content on a display (e.g. content information such as news, weather, etc. displayed on the display 14 as shown in Figs. 5-7), transmitting an indication of user inactivity (e.g. the time out period after the operating routines in Figs. 6 and 7, and col. 6, lines 63-65), receiving an advertisement via one of an Internet or a digital video broadcast network (e.g. col. 3, lines 46-61), and displaying the advertisement on the display (col. 5, lines 48-55 for example). Thompson also disclose the visual display can be bistable, thereby requiring no refresh buffer and requiring no power to maintain an image on the visual display 14 (e.g. see

col. 7 lines 34-36; this corresponds to removing power to the display, wherein the advertisement remains on the display after power has been removed as claimed).

As to claim 20, note the discussion of claim 1 above. Thompson also discloses the terminal (annunciator 10) includes RF wireless receiver for receiving, from a host device, selected information including news, weather, sports, broadcast medial content and advertising (this corresponds to receiving an advertisement at the time of downloading content).

As to claims 50 and 51, note the discussion of claims 1 and 20 above. Fig. 3 of Thompson teaches a memory device storing a program and a processor in communication with the memory device.

As to claim 53, Thompson teaches that anytime there is no activity the advertisement is displayed, and thereafter if the user activates the terminal, i.e. such as touch a channel key, power is returned to the terminal, e.g. see Fig. 4, this reads on power remains removed until user activity is detected.

As to claims 3, 23, Fig. 7 of Thompson teaches during operation once the desired channel is reached, the channel number will appear on the display for a time out period of a few seconds to a few minutes and then will return to a display of the advertisement (this corresponds to receiving the content, and detecting a predetermined period of user inactivity with respect to the content).

As to claims 4, 5, 24, 25, Thompson teaches the content and advertisement are received via the Internet or via a digital video broadcasting (e.g. col. 3, lines 46-61).

As to claims 7, 10, 27, 30, Thompson teaches the visual display is a bistable display, thereby requiring no refresh buffer and requiring no power to maintain an image on the visual

display 14, this corresponds to the advertisement remains on the display for an extended period of time after power has been removed, or removing power to the display after displaying the content, wherein the content remains on the display after power has been removed.

As to claims 9, 29, Figs. 6 and 7 of Thompson teaches once the operating routine is reached, the program returns the advertisement to the visual display, this corresponds the advertisement replaces the content on the display.

4. Claims 54, 56, 60, 61, 62, 64 are rejected under 35 U.S.C. 102(e) as being anticipated by Graham et al (US. PAT. NO. 6,804,659 hereinafter Graham).

No patentable weight is given to the claimed invention as having a "bistable display" since the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone.

As to claims 54, 61, Graham discloses a method and computer program for distributing online advertising to viewers at the users' terminal (Fig. 2) based upon the viewers' interests is provided, such as when a user is viewing a portion of a document which contains many highlighted keywords related to the user's concepts of interest, the user can be sufficiently interested in such a document portion to closely read the contents, therefore, advertising can be targeted based upon the information that the user is currently reading, the server can provide better advertising for a user based upon the current document the user being viewed. Fig. 1B of Graham discloses a method and computer program of advertising to a user of a terminal comprising storing content (document is stored in profile content recognizer), storing advertisements linked to the stored content (the advertisement is stored in the database 18),

receiving a request for content from the user terminal (e.g. see col. 10 lines 62-68), transmitting the requested content to the user terminal, selected an advertisement linked to the requested content, and transmitting the selected advertisement to the user terminal for display (see col. 4, line 64 to col. 6, line 47 for example).

As to claims 56, 64, Graham teaches the selected advertisement is transmitted separately from the requested content.

As to claims 60, 62, Figs. 1B and col. 5, line 46 to col. 6, line 6 of Graham teaches the content is stored in a content server (server 10 inherently comprising a content processor and its corresponding [first] program) and the advertisements are stored in advertisement server (18 inherently comprising a advertisement processor and its corresponding [second] program). As shown in process/processor in Fig. 1B, the document (i.e. content) that's send to the user is also used to determined the linked advertisement, therefore this reads on the content server notifying the advertisement server as to the content being transmitting to the user terminal; the advertisement server using this document and selecting the advertisement linked to the requested content, and transmitting the advertisement to the terminal user.

Claim Rejections - 35 USC § 103

5. Claims 2, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson in view of Shibata et al (US. PAT. NO. 6,888,522 hereinafter Shibata).

Thompson does not disclose the bistable display is a bistable reflective display. However, Shibata teaches a display is a reflective type LCD with a memory effect (bistable, col. 13, lines 46-48). Thus, it would have been obvious to one having ordinary skill in the art at the

time the invention was made to modify the display of Thompson to be a bistable reflective display as taught by Shibata since it has an advantage of saving energy.

6. Claims 11, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson in view of Ootsuka et al (US. PUB. NO. 2003/0103023 hereinafter Ootsuka).

Thompson teaches the visual display is a bistable display (display with memory effect), thereby requiring no refresh buffer and requiring no power to maintain an image on the visual display. Thompson does not disclose adding power to the display to clear the content. However, Ootsuka teaches a LCD display with memory effect (bistable display), the display is capable of keeping an image thereon without consuming electric power unless writing on the display is required (e.g., section [0054]). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the terminal of Thompson to add power to the display for writing the content (i.e. clear the old content and display new image) as taught by Ootsuka so as to achieve energy saving and effectively update the content image.

7. Claims 8, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson in view of Guyot et al (US. PAT. NO. 6,119,098 hereinafter Guyot).

Thompson does not explicitly disclose displaying a different advertisement on the display after predetermined period of time. However, Guyot teaches the substriber's terminal automatically accesses the server to download new advertisements such that the advertisement displayed on the substriber's terminal are always up to date. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Thompson to

update the advertisement on the display after predetermined period of time such that the advertisement displayed on Thompson's terminal are always up to date.

8. Claims 12-19, 32-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson in view of Guyot and Meyers et al (US. PAT. NO. 6,674,995 hereinafter Meyers).

As to claims 12, 32, Thompson does not explicitly disclose a second terminal, and transfer content to a second terminal. However, Guyot teaches a system for targeting and distributing advertisements over a distributed information network includes a plurality of terminals (subscriber systems). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Thompson to have a plurality terminals for receiving advertisements over a distributed information network such that the advertisements are effectively distributed to the user at vary locations throughout the premise to ensure viewing of the distributed advertisements. Meyers teaches a wireless telecommunication system comprising a plurality of terminals, and transferring data or information (such as advertisements, promotional information, e.g. see abstract) from one terminal to another terminal (e.g., col. 3, lines 5-43) through the use of short-range radio communication such as Bluetooth. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Thompson as modified by Guyot to transfer data or information to a different terminal as taught by Meyers such that the advertisements are effectively and efficiently transfer from one terminal to another throughout the premise.

As to claims 13, 14, 33, 34, Fig. 10 of Guyot teaches notifying the advertisement server of the content transfer (see step s651-s653).

As to claims 15, 35, Guyot teaches the subscriber data in one subscriber system including identification information, thus, Thompson as modified by Guyot and Meyers would have transmitting an identification of the transferred content.

As to claims 16, 36, Guyot teaches targeting the distributing advertisements over the Internet.

As to claims 17, 37, Meyers teaches the wireless telecommunication system comprising a plurality of terminals, receiving information from other terminals that are in close proximity of the terminal (e.g., col. 3, lines 5-43).

As to claims 18, 19, 38, 39, Meyers teaches the connection is a low power radio frequency or Bluetooth connection (col. 3, lines 49-54).

9. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson in view of Hamzy et al (US. PAT. NO. 6,636,247 hereinafter Hamzy).

Thompson does not disclose the advertisement is hyperlink on text. However, Fig. 6 of Hamzy teaches an advertisement comprising a hyperlink on text. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Thompson to have the advertisement is a hyperlink on text as taught by Hamzy so as to provide the user with fast access to additional information related to the displayed advertisement.

10. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson in view of Wodarz et al (US. PAT. NO. 5,999,912).

Thompson discloses receiving a plurality of advertisements at the time of downloading content. Thompson does not disclose the advertisement displayed is randomly selected from the plurality of advertisements. However, Wodarz teaches the advertisements are displayed according to scheduling criteria such as randomly selected, time based, etc. (col. 3 lines 62-67, col. 5, lines 25-30 for example). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Thompson to select the displayed advertisement randomly based the scheduling criteria set forth by the advertiser.

11. Claims 54-56, 60-64, 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson in view of Graham.

As to claims 54, 61, Thompson discloses a method of advertising to a user of a terminal (annunciator 10) having a bistable display (col. 7, lines 34-36), comprising displaying content on the display (e.g. content information such as news, weather, etc. displayed on the display 14 as shown in Figs. 5-7, it is inherent that the terminal storing content in order to display the content), receiving an advertisement via one of an Internet or a digital video broadcast network (e.g. col. 3, lines 46-61; it is inherent that the advertisements are stored in the advertisement data base), and displaying the advertisement on the display (col. 5, lines 48-55 for example). Thompson does not disclose storing advertisements linked to the stored content, receiving a request for content from the user terminal, selecting an advertisement linked to the requested content. However, Graham discloses a method and computer program for distributing online advertising to viewers at the users' terminal (Fig. 2) based upon the viewers' interests is provided, such as when a user is viewing a portion of a document which contains many highlighted keywords related to the

user's concepts of interest, the user can be sufficiently interested in such a document portion to closely read the contents, therefore, advertising can be targeted based upon the information that the user is currently reading, the server can provide better advertising for a user based upon the current document the user being viewed. Fig. 1B of Graham discloses a method and computer program of advertising to a user of a terminal comprising storing content (document is stored in profile content recognizer), storing advertisements linked to the stored content (the advertisement is stored in the database 18), receiving a request for content from the user terminal (e.g. see col. 10 lines 62-68), transmitting the requested content to the user terminal, selected an advertisement linked to the requested content, and transmitting the selected advertisement to the user terminal for display (see col. 4, line 64 to col. 6, line 47 for example). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Thompson to store advertisements linked to the stored content and select an advertisement linked to the requested content as taught by Graham so as to provide target advertisements that would be of interest to a user of the terminal.

As to claims 55, 63, Thompson teaches transmitting an indication of user inactivity (e.g. the time out period after the operating routines in Figs. 6 and 7, and col. 6, lines 63-65) and provides advertisement in response to user inactivity. Therefore, in Thompson as modified by Graham the displayed advertisement would be linked to the requested content and is transmitted to the terminal as claimed.

As to claims 56, 64, Graham teaches the selected advertisement is transmitted separately from the requested content.

As to claims 60, 62, Figs. 1B and col. 5, line 46 to col. 6, line 6 of Graham teaches the content is stored in a content server (server 10 inherently comprising a content processor and its corresponding [first] program) and the advertisements are stored in advertisement server (18 inherently comprising a advertisement processor and its corresponding [second] program). As shown in process/processor in Fig. 1B, the document (i.e. content) that's send to the user is also used to determined the linked advertisement, therefore this reads on the content server notifying the advertisement server as to the content being transmitting to the user terminal; the advertisement server using this document and selecting the advertisement linked to the requested content, and transmitting the advertisement to the terminal user.

As to claim 68, Thompson as modified by Graham does not explicitly disclose the content processor and the advertisement processor are the same processor. However, on col. 5 line 67 to col. 6 line 6 Graham discloses the processes can co-reside on an ISP server so that advertisers are unable to access the user's profile, thus it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Thompson as modified by Graham to have one single [the same] processor for performing the functions of the content processor and the advertisement processor to maintain user privacy.

12. Claims 57, 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson and Graham as applied to claims 54, 61 above, and further in view of Hamzy.

Thompson as modified by Graham does not disclose the advertisement is hyperlink on text. However, Fig. 6 of Hamzy teaches an advertisement comprising a hyperlink on text. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was

made to modify Thompson as modified by Graham to have the advertisement is a hyperlink on text as taught by Hamzy so as to provide the user with fast access to additional information related to the displayed advertisement.

13. Claims 58, 59, 66, 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson and Graham as applied to claims 54, 61 above, and further in view of Guyot.

As to claims 58, 66, Thompson as modified by Graham does not explicitly disclose displaying a new advertisement. However, Guyot teaches the substriber's terminal automatically accesses the server to download new advertisements such that the advertisement displayed on the substriber's terminal are always up to date. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Thompson as modified by Graham to update the advertisement on the display such that the advertisement displayed on Thompson's terminal are always up to date.

As to claims 59, 67, see col. 4, lines 15-23 of Guyot.

Allowable Subject Matter

14. Claims 41-49, 52 are allowed.

15. Claims 6 and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Regina Liang whose telephone number is (571) 272-7693. The examiner can normally be reached on Monday-Friday from 8AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Edouard, can be reached on (571) 272-7603. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Regina Liang
Primary Examiner
Art Unit 2674

5/12/05